

PATENT
Docket: NCR11393

RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
GROUP ART UNIT 1772

REMARKS

Reconsideration of the above identified application is respectfully requested.

On 08/22/2006, the undersigned attorney conducted a phone interview with examiner Watkins to briefly discuss the latest rejections of record.

The different features of independent claims 1, 20, and 21 were discussed, along with the different interpretations thereof relative to the new Section 112 rejection, and the renewed rejections under Sections 102 & 103.

In para. 1 at page 2 of the office action, the examiner recognizes the patentable novelty of the stationery sheets recited in independent claims 1, 20, and 21 due to the arrangement of the repeating diecuts corresponding to the sheet stacking 10a,10b,10a,10b et seq, for example.

At pages 3 and 4 of the office action, the examiner raises the new issue under Section 112, but indicates the art rejections of the claims could be withdrawn "... if clearly claimed as explained above."

The continuing problem in evaluating the claims is recognizing that the diecuts in adjoining sheets in the stack are offset from each other to prevent the interlocking problem, but otherwise are aligned with each other in the stack.

In other words, the diecuts in adjoining sheets 10a,10b are offset, and then the diecuts in the next adjoining sheets 10b,10a are again offset, etc.

But, the diecuts in the series of repeating sheets 10a are the same and aligned with each other; and the diecuts in the series of repeating sheets 10b are the same and aligned with each other.

Independent claims 1, 20, and 21 were originally prepared, and have been repeatedly amended to recite this special cooperation, yet the examiner continues to challenge

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the interpretation thereof.

Simple amendments to claims 20 and 21 were discussed to emphasize the slit diecuts therein.

And, then the phone interview was suspended until the following day, 8/23, to allow this attorney to develop optional amendments to claim 1 in an attempt to resolve the examiner's concerns thereof.

Claim 1 as presently amended above re-introduces previous features to the claim, and further introduces the two types of stacked sheets as first and second, corresponding to sheets 10a and 10b disclosed in the specification.

In this way the diecuts in adjoining sheets, like 10a & 10b or 10b & 10a, are offset from each other; and the diecuts in the first sheets 10a,10a,10a etc are aligned with each other, and the diecuts in the second sheets 10b,10b,10b etc are aligned with each other, recognizing that the first and second sheets alternate in the stack.

Claims 3 and 5 have also been amended to conform with claim 1 since features thereof are now found in amended claim 1.

Furthermore, claims 5 and 20 are being similarly amended to recite that the diecuts are offset in the adjoining sheets but also aligned in the "next successive sheet" (10a or 10b) relative to the originally recited adjoining sheets (10a and 10b) as disclosed at para. 33 for example. In other words, the diecut in sheet 10a is offset in the adjoining sheet 10b, but aligned with the next successive sheet 10a.

This arrangement is disclosed at para. 33, for example.

Although no agreement was reached, these amendments are being presented in an attempt to resolve the concerns of the examiner and his supervisor in evaluating the significance of the exemplary 10a,10b,10a,10b stacking, recognizing also the applicability of the different stacking examples presented in para. 34, and others.

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Nevertheless, Applicant traverses the rejection of claims 1-12 and 20 under 35 USC 112, second paragraph.

The examiner's interpretation of the claims as presented at pages 2 & 3 of the office action are generally, but not completely, correct.

In particular the examiner's contentions are not correct because of the examiner's attempt to summarize the three independent claims 1, 20, and 21 for the similarities recited therein, without due regard to their differences; since, of course, those claims must be different from each other and have different scope.

At page 4 of the office action, the examiner has again failed to address the specifically recited claim language in presenting the Section 112 rejection, and has again incorrectly summarized the claims in the exemplary statement that "It is unclear how these sheets can have both identical and offset slits as required by the claim [1]."

Further compounding the errors of rejection is the examiner's attempt to overly narrow the interpretation of the claims under the Section 112 rejection, but remarkably broaden their interpretation for the art rejections under Sections 102 & 103. The examiner thusly creates considerable ambiguity in the scope of the claims and their fundamental differences over the various references of record.

Figures 2 & 3 illustrate an exemplary embodiment of the stacked sheets 10a,10b,10a,10b etc.

Those sheets are basically identical as well explained in the specification, except for the placement or location of the diecuts 16a,b,c therein.

As the examiner recognizes at pages 2 & 3 of the office action, every other sheet 10a,10a, etc and 10b,10b, etc have identical diecuts 16a,b,c which are therefore aligned with each other in the common stack thereof.

The examiner also recognizes that the "adjoining" sheets ["next" being superfluous] in the stack have offset diecuts.

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The examiner emphasizes this cooperation of features at the top of page 3 of the office action by stating that Haggerty "... clearly teaches away from every other sheet having identical aligned slits."

The examiner's use of "every other" is significant since the examiner expressly recognizes the plain meaning of the claim language, yet has overlooked the corresponding meaning of the "alternating sheets" recited in claim 1 for example.

Webster's New World Dictionary, second college edition, defines "alternate" as including "every other; every second [to report on alternate Tuesdays]."

This definition not only conforms with the examiner's own description and interpretation, but conforms with Applicant's express description of this feature presented in the specification, illustrated in the drawings, and recited in the claims.

The examiner's contention at page 4 that "Thus alternate sheets would appear to be the adjoining pair of 10a and 10b" is an incorrect interpretation of the entirety of the claim language, and fails to recognize that the stack can have a multitude of stacked sheets, with two or more adjoining sheets, and one or more non-adjoining sheets, that nevertheless "alternate."

The examiner appears to interpret the claims not for the plain and correct meaning, but for distorted and incorrect meanings.

There can be no doubt that the examiner recognizes the novelty in the 10a,10b,10a,10b stacking arrangement as he presents at page 2 of the office action; the difficulty lies in affording due weight to the claims.

And, quite simply the sequence of sheets has both adjoining sheets like 10a,10b and alternate sheets which would be the 10a's and 10b's which alternate with each other.

Indeed, the dictionary definition presented above for alternate as being "every other" or "every second" recognizes

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its meaning in a series of items for which the examiner has failed to afford due weight.

In the interview, the examiner even indicated that his interpretation of "every other" is the same as "every," which renders unreasonably difficult the presentation of claim language for meeting the subjective standards of the examiner.

Nevertheless, in view of the examiner's cooperation in the phone interview, it would appear that the claims have been suitably amended to emphasize the different nature of the adjoining and alternate sheets with offset and aligned diecuts, and this should resolve the examiner's concerns for independent claims 1 and 20.

And, both claims 5 and 20 recite the two-configuration species disclosed at para. 34 in which the diecut in sheet 10a is offset with the diecut in the adjoining sheet 10b, and aligned in the "next successive" sheet 10a; language not previously found in claim 5's parents.

This species is different than the three-configuration species, or more, in which the series would include 10a,10b,10c,10a,10b,10c where the diecut in the first sheet 10a would be offset with both those in the next two sheets 10b,c, but aligned with the diecut in the fourth sheet 10a in the series.

Nevertheless, claims 5 & 20 have been similarly amended at the request of the examiner to further emphasize this species as presented in more detail in para. 33.

And, claim 6 simply recites that the different offsets repeat in (further) successive sheets, see para. 34 for example, in additional language not previously recited, and therefore clearly providing a further limit.

Accordingly, withdrawal of the rejection of claims 1-12 and 20 under 35 USC 112, second paragraph, is warranted and is requested.

Applicant traverses the repeated rejection of claims 1-

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4, 7-9, and 11 under Section 102(b) over Haggerty for the reasons previously presented, and not rebutted by the examiner.

Applicant traverses the repeated rejection of claims 5, 6, and 20 under Section 103(a) over Haggerty for the reasons previously presented, and not rebutted by the examiner.

At the bottom of page 2 of the office action, the examiner admits the inapplicability of Haggerty, which was reinstated solely due to the Section 112 rejection.

Since the Section 112 rejection should now be resolved, both rejections under Section 102 and 103 over Haggerty should now be resolved, and withdrawn, which is respectfully requested.

Applicant traverses the renewed rejection of claims 20-23 and 25 under Section 102(b) over May for the same reasons previously presented, and not rebutted by the examiner.

At the bottom of page 3 of the office action, the examiner indicates that the sole reason to reintroduce the May reference was the omission of the "slit diecut" feature.

However, the examiner has overlooked that independent claim 20 still contains the "slit diecut" feature, which was not removed therefrom, and therefore the rejection of claim 20 lacks merit.

As for independent claim 21, the slit feature has now been reintroduced therein in the above amendment.

Accordingly, withdrawal of the rejection of claims 20-23 and 25 under Section 102(b) over May is warranted and is requested.

Applicant traverses the reinstated rejection of claims 20-25 under Section 103(a) over paras. 5 & 9 of Applicant's specification and May for the same reasons previously presented, and not rebutted by the examiner.

Yet again, the examiner has overlooked the slit diecut feature in independent claim 20 rendering without merit the reinstatement of the rejection thereof.

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And, since independent claim 21 has been amended to reintroduce the slit diecut feature, the Section 103 rejection thereof now additionally lacks merit.

Accordingly, withdrawal of the rejection of claims 20-25 under Section 103(a) over paras. 5 & 9 of Applicant's specification and May is warranted and is requested.

In view of the above amendments and remarks, allowance of claims 1-12 and 20-25, over the art of record is warranted and is requested.

And, withdrawal of the restriction requirement is further warranted and requested; and method claims 13-19 should now be rejoined, and the prior art search again updated specifically therefor, along with due examination of these method claims as well. See MPEP 821.04.

Those method claims 13-19 are well distinguishable over the art of record, both for their dependence from the novel product claims, and additionally for the patentable novelty of those method claims in combination therewith.

Allowance of method claims 13-19 is also warranted and is requested, in addition to claims 1-12 and 20-25.

Respectfully submitted,



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